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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/588,443      | 06/06/2000  | Robert A. Law        | E-848               | 9187             |

919 7590 08/10/2005

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EXAMINER

JEANTY, ROMAIN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3623

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/588,443 | <b>Applicant(s)</b><br>LAW, ROBERT A. |  |
|                              | <b>Examiner</b><br>Romain Jeanty     | <b>Art Unit</b><br>3623               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-8, 11-13 is/are rejected.
- 7) ☒ Claim(s) 4,5,9,10,14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Final Office Action is in response to the communication received May 23, 2005.

Claims 1-15 are pending in the application.

### **Response to Arguments**

2. Applicant's arguments filed May 23, 2005 have been fully considered but they are not persuasive.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6, 11 and are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (U.S. 6,463,462).

As per claims 1, 6, 11, Smith et al discloses a method for delivery of messages to multiple recipients comprising:

a plurality of messaging system for processing respective messages intended for recipients (col. 2, lines 36-41);

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a data center data processing in operative communication with the plurality of messaging systems for storing transaction data associated with each respective message processed by the messaging systems intended for the recipients (col. 4, lines 44-64);

a control system in operative communication with the data center for identifying selected transaction data from among the transaction data corresponding to a defined recipient (col. 4, lines 36-54);

using the selected relevant transaction data to generate a recipient profile of messages intended for the defined recipient that have been processed by the plurality of messaging systems (col. 6, lines 1-30).

5. Claims 2-3, 7-8 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (U.S. Patent No 6,463,462) in view of Sheppard et al (U.S. Patent No. 6,026,397).

As per claims 2, 7, and 12, Smith et al do not explicitly disclose the concept of segmentation information developed from the selected transaction data that organizes the messages intended for the defined recipient into categories. Sheppard in the same of endeavor discloses segmenting customer information into clustering (col. 5, lines 11 through col. 12 line 23). It would have been obvious to a person of ordinary skill in the art to modify the disclosures of Smith et al to include segmentation information developed from the selected transaction data that categorizes the message intended for the defined recipient categories as taught by Sheppard in order to perform statistical analysis on the information.

As per claims 3, 8, and 13, the combination of Smith et al and Sheppard does not explicitly disclose using the segmentation information to develop inferences about the defined recipient in the recipient profile. However, using segmentation information to develop inferences

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about a defined recipient in the recipient profile is old and well known in the marketing art.

Thus it would have been obvious to a person of ordinary skill in the art to modify the disclosures of Smith et al and Sheppard to include using segmentation information to develop inferences about a defined recipient in the recipient profile for the purpose of customizing and personalizing content for the user. Applicant is referred to col. 2, lines 46-55; and col. 5, line 66 through col. 6 line 7 of Kramer (U.S. Patent No. 6,327,574) for this well known teaching.

#### **Allowable Subject Matter**

6. Claims 4-5, 9-10, and 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Prior art of record fails to teach or suggest the plurality of messaging systems are operated by respective senders, each respective sender has associated classification data indicating an industry segment that describes the respective sender's activities and the control system is for further using the sender classification data to store an indication in the recipient profile of types of senders that originated the messages intended for the defined recipient, the inferences are developed from the sender classification data and include one or more of the following insights: characteristics, preferences and interests of the defined recipient.

#### **Remarks**

Applicant argues that Smith et al (US Patent No. 6,463,462) does not teach the claimed invention. Applicant further supported his assertion by arguing that Smith fails to teach or fairly

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suggest using the selected transaction data to generate a recipient profile of messages intended for the defined recipient that have been processed by the plurality of messaging systems. In response, the examiner respectfully disagrees with applicant's argument because Smith does teach that selected the recipient based on the recipient profile in order to send messages to the recipient based on the profile information. Note column 4, lines 36-57.

Further, Applicant argues that the references (Smith et al US Patent No. 6,462,462, and Shepherd et al US Patent No. 6,026,397) do not describe in any way organizing messages into categories. In response, the examiner disagrees with applicant's arguments because Smith et al does disclose the concept of the recipient selecting a category for delivering the messages to the recipient. Note column 4, lines 4-9 of Smith et al. In addition, applicant asserted that applicant is not sure of the context of the term "recipient" and that applicant disagrees with the entire statement of Official Notice. In response, the examiner respectfully disagrees with applicant assertion because the content of the "recipient" is taught by Smith et al. Note the abstract of Smith et al. Furthermore, applicant has attempted to challenge the Examiner's taking of Official; however, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice. Thus, the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well known statements. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegation." However, "bald statements such as 'applicant

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disagrees with the examiner's taking of Official Notice, is not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection of notoriously well known facts" (*In re Boon*, 169 USPQ 231 (CCPA 1971)). Therefore, the Examiner's taking of Official Notice has been maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

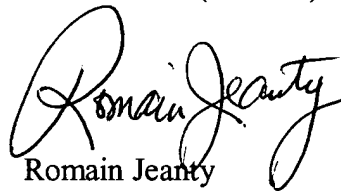
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 8, 2005

A handwritten signature in black ink, appearing to read "Romain Jeanty". The signature is stylized with a large, looping initial "R" and a cursive "Jeanty".

Romain Jeanty  
Primary Examiner  
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